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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,817	11/26/1999	Mitchell S. Steiner	P-2762-US1	6736

49443 7590 06/21/2006

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EXAMINER	
SCHNIZER, HOLLY G	

ART UNIT	PAPER NUMBER
1656	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/449,817	**Applicant(s)** STEINER ET AL.	
	Examiner Holly Schnizer	**Art Unit** 1656	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 6/7/06. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1,7,10,11,18-27,56,59 and 60.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

NASHAAT T. NASHED PHD.
PRIMARY EXAMINER

6-13-06

Continuation of 11. does NOT place the application in condition for allowance because: The amendment and request does not overcome the rejections under 35 U.S.C. 112, first paragraph for lack of enablement and written description for reasons cited in the previous Office Actions mailed 7/6/04 and 12/8/05. Applicants argument that the partial human p-HYDE sequence disclosed in SEQ ID NO:1 along with the full length rat p-HYDE sequence and the similar functions and high degree of homology would provide adequate enablement to make and use the human p-HYDE gene has been considered but is not persuasive for reasons cited in the previous Office actions. First, it is noted that Applicants have again have argued the claims are enabled when the rejection is a "written description" rejection. The examiner has previously addressed that the written description provision of 35 U.S.C. 112, is severable from its enablement provision (see p. 7-8 of OA mailed 12/8/05). The claims are drawn to a genus of sequences that encode a human p-Hyde protein that comprises the sequence of SEQ ID NO:1. Thus, the genus encompasses cDNA sequences as well as the full length p-HYDE gene sequence (which would contain exons and introns) However, the specification does not describe even a species--a full length nucleotide sequence that would encode a p-HYDE protein. Therefore, the specification does not describe a representative number of species to represent the genus (see previous OA for full discussion of this issue). Regarding the rejection under 35 U.S.C. 101, Applicants argue that they are not claiming a partial sequence of the human p-HYDE but the full length gene which would have utility. This argument has been considered but is not deemed persuasive because the claims are drawn to isolated nucleic acid molecules encoding a human p-HYDE protein comprising the sequence of SEQ ID NO:1. SEQ ID NO:1 is a partial p-HYDE sequence and not the full length p-HYDE gene sequence. Thus, the claims encompass less than the full length sequence of the p-HYDE gene. Thus, the claims are rejected for the reasons provided in the previous Office Actions. .

Continuation of 13. Other: The examiner maintains that the elected subject has priority to the filing date of the instant application, November 26, 1999. Applicants argue that the sequence disclosed in the priority Application was a partial sequence and that there is no basis for requireing disclosure of a complete DNA sequence. This argument has been considered but is not deemed persuasive because as stated in the previous Office Actions, the amino acid sequence translated from SEQ ID NO:1 has a different sequence than that translated from SEQ ID NO:5 of the priority application (they are 99% identical meaning that there is at least one nucleotide difference).

The sequence listing filed 6/7/06 has been received and entered. The application is now considered in compliance with the sequence rules.